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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,786	04/05/2001	Patrick Montoya	AUT-10002/36	4084
25006 7590 09/11/2009 GIFTORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021				
EXAMINER				
LOFTIS, JOHNNA RONEE				
ART UNIT		PAPER NUMBER		
3624				
MAIL DATE		DELIVERY MODE		
09/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/826,786

Applicant(s)

MONTOYA, PATRICK

Examiner

JOHNNA R. LOFTIS

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9,10,15,16 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,10,15,16 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. The following is a final office action upon examination of application number 09/826,786. Applicant elected to file an Amendment/Argument after Examiner's Answer to Appeal Brief. Claims 1, 3-7, 9, 10, 15, 16 and 31 are pending and have been examined on the merits discussed below.
2. In view of the Amendment filed on 12/8/08, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624.

Response to Arguments

3. Applicant's arguments filed 12/8/08, after Examiner's Answer to Appeal Brief have been fully considered but they are not persuasive. The amendments to the claims are insufficient to overcome previous rejections under 35 USC 101. For a claim to be considered statutory under 35 USC 101 the claim must positively recite the particular apparatus that accomplishes the method steps. In this case, the claims are directed to data transfer over the Internet but it is not clear whether the claims are only directed to the computer program (software) that permits the steps to occur.
4. Further, the amendments to the claims raise new issues under 35 USC 112, 2nd paragraph.
5. Lastly, Examiner has reviewed arguments with respect to rejections in view of West. Based upon the amendments to the claims and the newly raised rejections under 35 USC 112, 2nd paragraph Examiner is upholding those rejections.

West teaches a client requesting survey results from a survey collector, wherein the client requests information to determine if the client has responded to the survey previously (the survey results of West include a record of who has responded to the survey). Once the client responds to the survey, the results of the survey are displayed. If a survey response has previously been completed by the client, when the client sends the request for the story (and related survey results) the client is not presented with the survey since it was already completed by that client.

Further, the claim language only requires the client is provided access to the survey results which include responses that are unrelated. Once the client completes a survey in the West system, the client is granted access to the survey results. Inherent to the West system is the

fact that a plurality of surveys and their corresponding results are stored and one is only granted access to results if a survey is completed.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 3-7, 9, 10, 15, 16, 31 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. The apparatus must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a

specific article in an insignificant step, such as data gathering or outputting is not sufficient to pass the test.

Applicant's method steps fail the first prong of the new Federal Circuit decision since they recite a mere field-of-use. Thus, claims 1, 3-7, 9, 10, 15, 16, 31 are non-statutory.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3 and 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is not clear whether the collected survey results are related or unrelated to the survey questionnaire. Claim 1 states the results are unrelated to the survey questionnaire. Claims 3 and 4 state the results are related to the survey questionnaire. Clarification must be made for examiner to get a full understanding of what is intended by the claim language.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1, 3, 5, 9, 10, 15, and 16 rejected under 35 U.S.C. 102(e) as being anticipated by West et al et al, US 6,175,833.

As per claim 1, West et al teaches establishing communication between a client and a survey collector having previously collected survey results, the results including a composite survey response (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys); receiving by the survey collector a request from the client for the previously collected survey results (column 9, lines 19-36 – user requests story along with survey results; column 7, line 59 – column 8, line 60); providing the client with a survey questionnaire from the survey collector (column 7, line 54 – column 8 line 67 – user is presented a survey if the user has not already submitted a vote); providing access to the previously collected survey results to the client only if the survey collector receives a response to the survey questionnaire from the client, the results including a composite survey response that is unrelated to the survey questionnaire (column 9, lines 19-36 – user must first vote before viewing survey results; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys); rejecting the client's request for the survey results if a response to the survey questionnaire is not received from the client (column 9,

lines 19-36 – inherently if the user does not vote, he/she does not gain access to the survey results).

As per claim 3, West et al teaches relating the survey questionnaire by subject matter to the previously collected survey results (column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 5, West et al teaches providing the client with the survey questionnaire includes requesting the identifying indicia from the client (column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 9, West et al teaches receiving by the survey collector identifying indicia from the client (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier; column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)); and correlating the identifying indicia with a database to determine if a relationship exists between the identifying indicia and the subject matter of the survey questionnaire (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier; column 8, lines 41-65 – survey ID used to correlate with user's global unique identifier (GUID)).

As per claim 10, West et al teaches receiving by the survey collector identifying indicia from the client (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier); and correlating the identifying indicia with a database to determine determining if a relationship exists between the identifying indicia and the client (column 5, lines 47-50 and

column 6, lines 28-48 – obtains user's global unique identifier determines whether user has voted previously).

As per claim 15, West et al teaches the client is denied access to the previously collected survey results if no relationship is found between the indicia and the client (column 9, lines 19-36 – inherently if the user does not vote, he/she does not gain access to the survey results).

As per claim 16, West et al teaches assimilating the survey response into a composite survey response (column 3, lines 38-63 – computer network system; column 4, lines 16-27 – online voting; inherently the system contains voting results for all surveys).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 6, and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over West et al, US 6,175,833.

As per claim 4, West et al teaches the creation of surveys (column 5, lines 1-22) but does not explicitly teach the request for previously collected survey results and the survey questionnaire are related to automotive vehicles; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same

regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.

As per claim 6, West et al teaches identifying indicia (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier), but does not explicitly teach the indicia is a product identification number; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.

As per claim 7, West et al teaches identifying indicia (column 5, lines 47-50 and column 6, lines 28-38 – obtains user's global unique identifier), but does not explicitly teach the indicia is a VIN number; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP, 2106.

15. Claim 31 rejected under 35 U.S.C. 103(a) as being unpatentable over West et al, US 6,175,833, further in view of Stiles, US 6,330,608.

As per claim 31, West et al teaches receiving by the survey collector identifying indicia from the client and only providing survey results if the user's global unique identifier is correlated and shows the user has previously voted (column 5, lines 47-50 and column 6, lines 28-48 – obtains user's global unique identifier), but does not explicitly teach correlating the identifying indicia with a database to determine if the client is a registered member and providing access only if the client is also a registered member. Stiles teaches a method and system for registering modules or service providers requesting access to a computer system, its hardware and/or its software wherein only registered modules will access to the computer system. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the survey system of West et al the registration function as taught by Stiles since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shao et al, US 7310350 – Mobile surveys and polling

Fuerst, US 6189029 – web survey tool builder and result compiler

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
8/25/09

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624